

ATTORNEY DOCKET NO. 9435.2  
Application Serial No.: 10/721,563  
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### **REMARKS**

Claims 5-10, 12-17 and 19-29 are pending in this application. Claims 16 and 24-29 are canceled herein without prejudice. Claims 10, 17 and 20 are amended herein for clarity to more particularly define the invention. Support for these amendments is found in the language of the original claims and throughout the specification, as set forth below. No new matter is added by these amendments and their entry and consideration are respectfully requested. In light of these amendments and the following remarks, reconsideration of this application and allowance of the pending claims is respectfully requested.

Applicants note that the present Office Action states that claims 5-8, 12-15 and 19-23 are allowed.

#### **I. Objection to the specification**

The Office Action states that the specification is objected to for allegedly failing to provide proper antecedent basis for the term "circular retroviral form plasmid" as recited in claim 20.

Applicants respectfully point out that claim 20 was amended in the May 5, 2006 Response to recite "circular retroviral form plasmid" rather than "circular HIV-1 form plasmid" pursuant to a telephone conference between the undersigned and Examiner Burkhart on April 17, 2006, wherein it was applicant's understanding that the Examiner requested this amendment in order to put the claim in condition for allowance. However, to address the present objection and to expedite this application to allowance, claim 20 is amended herein to again recite "circular HIV-1 form plasmid" pursuant to the original claim language. Thus, applicants respectfully request the withdrawal of this objection and allowance of the pending claims to issue.

#### **II. Rejection under 35 U.S.C. § 112, second paragraph**

The Office Action states that claims 24-29 are rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite.

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Claims 24-29 are canceled herein without prejudice, thereby mooted this rejection and applicants respectfully request its withdrawal.

**III. Rejection under 35 U.S.C. § 112, first paragraph (new matter)**

The Office Action states that claims 9, 10, 16 and 17 are rejected under 35 U.S.C. § 112, first paragraph, as allegedly containing new matter. In particular, the Office Action states that the specification does not support nucleic acids wherein the recited portion of U3 is deleted or retained and a *loxP* site is within the U3.

Claim 16 is canceled herein without prejudice, thereby mooted this rejection as it applies to this claim.

Claims 10 and 17 are amended herein to depend directly from claims 5 and 13, respectively. Support for this embodiment, wherein the deleted U3 region is replaced with an inducible promoter is found at least in paragraphs 55, 56 and 91 and in Example III (paragraph 97), wherein the U3 region of the vector pTK474 has been replaced with a tetracycline-inducible promoter.

Claim 9 recites the nucleic acid of claim 5, wherein enhancer and promoter sequences of the U3 region of the LTR are deleted and minimal sequences required for integration at the 5' end of the LTR are not deleted and the *LoxP* site is not deleted. Support for the embodiment of claim 9 is found in the specification in Example II, (paragraph 95), wherein it is described that a *LoxP* site was incorporated into the U3 region of a SIN single-LTR HIV-1 vector (pTK589). A SIN vector is defined in the specification in paragraph 55, in paragraph 91 and in Example III (pTK485), as a vector from which the enhancer/promoter sequence of the U3 region of the LTR have been deleted. Thus, pTK589 is a vector from which this region of U3 has been deleted and which contains a *LoxP* site. Thus, the embodiment of claim 9 is adequately supported in the specification as filed. Applicants believe this rejection has now been overcome and its withdrawal is respectfully requested.

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**IV. Rejection under 35 U.S.C. § 112, first paragraph (enablement)**

The Office Action states that claims 24-29 are rejected under 35 U.S.C. § 112, first paragraph, as allegedly lacking enablement.

Claims 24-29 are canceled herein without prejudice, thereby mooted this rejection and applicants respectfully request its withdrawal and allowance of the pending claims to issue.

Having addressed all of the issues raised in the Office Action, applicants present claims herein that are in condition for allowance, which action is respectfully requested. The Examiner is encouraged to contact the undersigned directly if such contact will expedite the examination and allowance of the pending claims.

No fee is believed due with this response. However, the Commissioner is hereby authorized to charge any deficiency or credit any overpayment to Deposit Account No. 50-0220.

Respectfully submitted,



Mary L. Miller

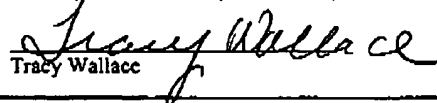
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**CERTIFICATE OF FACSIMILE TRANSMISSION UNDER  
37 C.F.R. § 1.8**

Date of Deposit: October 31, 2006

I hereby certify that this correspondence is being submitted to the United States Patent and Trademark Office under 37 CFR 1.8 via facsimile transmission to 571-273-8300 on the date indicated above and is addressed to Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

  
Tracy Wallace